

## **REMARKS / ARGUMENTS**

### **Status of the Claims**

Claims 1-5, 7-13, 15-21, and 23-30 are currently present in the Application, and claims 1, 9, 17, and 25-30 are independent claims. Claims 1, 2, 4, 7, 9, 10, 12, 15, 17, 18, 20, 23, and 25-30 have been amended, claims 6, 14, and 22 have been canceled, and no claims have been added in this Response.

### **Drawings**

Applicant notes with appreciation the acceptance by the Examiner of Applicant's formal drawings filed on 14 October 2003.

### **Claim Rejections Under 35 U.S.C. § 112**

Claims 2, 4, 7, 10, 12, 18, 20, 25, 26, and 28-30 were rejected under 35 U.S.C. § 112 for having insufficient antecedent basis for limitations presented in these claims. Applicant has amended the claims and provided proper antecedent basis for each of the claim limitations rejected. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 112 in light of these amendments.

### **Claim Rejections - Alleged Anticipation Under 35 U.S.C. § 102**

Independent claims 1, 9, and 17 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated and therefore unpatentable over U.S. Patent Publ. No. 2004/0203746 to Knauerhase et al. (hereinafter "Knauerhase"). Applicant respectfully traverses the rejections.

As discussed in detail below, Applicant found that the limitations presented in original claims 6, 14, and 22 are not taught or suggested by the prior art. These claims were rejected under 35 U.S.C. § 103 as allegedly being obvious over art of record. Independent claims 1, 9, and 17 have been amended to include limitations originally presented in claims 6, 14, and 22, respectively, and claims 6, 14, and 22 have been canceled. The rejections under 35 U.S.C. § 102(e) are therefore moot in light of Applicant's amendments.

**Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103**

The Office Action rejected original claims 6, 14, and 22 under 35 U.S.C. § 103 as allegedly being obvious, and therefore unpatentable, over U.S. Patent Publ. 2004/0203746 to Knauerhase et al. (hereinafter, “Knauerhase”) in view of U.S. Patent No. 6,785,681 to Keskar et al. (hereinafter, “Keskar”). As discussed in the previous section, independent claims 1, 9, and 17 have been amended to include the limitations originally found in claims 6, 14, and 22, respectively, and original claims 6, 14, and 22 have been canceled. Applicant respectfully traverses the rejection of amended claims 1, 9, and 17 as allegedly being obvious, and therefore unpatentable, over Knauerhase in view of Keskar. In addition, Applicant has amended independent claims 25, 27, and 29 to include the limitations originally found in claims 6, 14, and 22 and respectfully traverses the rejections of claims 25, 27, and 29.

Finally, independent claims 26, 28, and 30, as filed, included limitations found in claims 6, 14, and 22. These claims were rejected under 35 U.S.C. § 103 as allegedly being obvious, and therefore unpatentable over Keskar in view of U.S. Patent No. 6,785,681 to Malik (hereinafter, “Malik”). Applicant respectfully traverses the rejection of claims 26, 28, and 30.

Applicant asserts that the Office Action fails to establish a prima facie case of obviousness under § 103 as set forth in § 103 and the MPEP. MPEP 2142 states that:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art**, and not based on applicant’s disclosure.”

Applicant asserts that the Office Action fails to show that the prior art references teach or suggest all of Applicant's claim limitations. In particular, Applicant asserts that the Office Action fails to view Applicant's invention as a "whole." MPEP 2141 states that "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole..."

MPEP 2143.03 states:

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art...**All words** in a claim must be considered in judging the patentability of that claim against the prior art" (emphasis added)

Applicant asserts that the Office Action fails to consider all words in Applicant's claims as a whole during their patentability judgment, which is described in greater detail below.

**Claims 26, 28, and 30:**

The Office Action contends that the limitations presented in claims 26, 28, and 30 are taught by the Keskar in combination with Malik. Comparing the limitations found in claims 26, 28, and 30 with the teachings of Keskar and Malik, however, reveals that neither Keskar nor Malik, taken alone or in combination with one another, teach or suggest Applicant's claimed limitations.

Claims 26, 28, and 30 each include the following limitations:

- creating a buddy group within a user's buddy list, wherein the created buddy group corresponds to a selected calendar entry from an electronic calendar corresponding to the user, and wherein the user's buddy list is associated with an instant messaging computer application;
- identifying an expiration date of the buddy group, the expiration date derived from a date of the selected calendar entry;

- retrieving, from the selected calendar entry, calendar data that includes contact data for participants of the selected calendar entry;
- storing the received contact data in the buddy group, wherein the contact data received includes participant information;
- periodically comparing a current date to the expiration date corresponding to the buddy group; and
- removing the buddy group, including the contact data added to the buddy group, in response to the comparison.

The Office Action contends that Keskar teaches the limitation of “creating a buddy group within a user’s buddy list, wherein the created buddy group corresponds to a selected calendar entry from an electronic calendar corresponding to the user, and wherein the user’s buddy list is associated with an instant messaging computer application,” citing col. 5, lines 31-55 as support for this contention. However, a review of Keskar exposes the fact that Keskar simply does not teach or suggest “creating a buddy group within a user’s buddy list.” Instead, as will be shown below, Keskar simply teaches adding contacts to a user’s buddy list *without* segregating the contacts into separate buddy groups. The cited section of Keskar reads as follows (with emphasis added):

Once the list of people 17 has been generated (block 104), the list is presented 106 to the user on the display 39. Additional criteria can be applied to the list of people 17 before the list is presented to the client 12a. The criteria can help refine the names of persons in the list 17 and can include factors such as the physical location of the recipient, the organizational distance of the recipient relative to the sender (i.e., same team, department, division, etc.), the structural distance of the recipient relative to the sender (i.e., peer, a level up or down in management, etc.), currently scheduled meetings for the sender (i.e., current working group, etc.), recent communication by the sender (i.e., email, instant messages, SMS messages, etc.), or periodic correspondence communication (i.e., one week ago, one quarter ago, etc).

The foregoing techniques can improve the task efficiency. By automatically providing a list of people 17 that are relevant to the task and content, the client 12a may avoid the need to search through a large address book to create the list. In an email application, recipients who may have an interest can be presented automatically to the author of an email message. Similarly, meeting attendees can be added to the list of people as the meeting agenda and other content are being added to the meeting notice. **In an instant messaging scenario, the list of people who might be interested in similar content can be added to a buddy list.**

Keskar is directed to generating lists of people relevant to a task (see title, abstract). In the cited section, Keskar contemplates presenting the list to the user (client 12a, col. 5, lines 31-34). Keskar does state that: "In an instant messaging scenario, the list of people who might be interested in similar content can be added to a buddy list," however Keskar simply does not teach or suggest "creating a buddy group **within the user's buddy list...**" as taught and claimed by Applicant. Each of Applicant's claims clearly differentiates between a "buddy list" and a "buddy group" that is a subset ("within") the buddy list.

The Office Action further contends that Keskar teaches the limitations of "retrieving, from the selected calendar entry, calendar data that includes contact data for participants of the selected calendar entry;" and "storing the received contact data in the buddy group, wherein the contact data received includes participant information." However, Applicant has established that Keskar does not teach or suggest using "buddy groups." It therefore follows that, without teaching buddy groups, Keskar cannot, and does not, teach or suggest "storing the received contact data in the buddy group..."

The Office Action contends that Malik teaches the steps of "identifying an expiration date of the buddy group, the expiration date derived from a date of the selected calendar entry;" periodically comparing a current date to the expiration date corresponding to the buddy group;" and "removing the buddy group, including the contact data added to the buddy group, in response to the comparison." Applicant respectfully disagrees. Malik simply does not teach or suggest setting expiration dates

to “buddy groups.” Instead, Malik teaches a way for a “temporary contact” to be added to a “resource list 305.”

The Office Action cites paragraph [0045] of Malik as teaching setting expiration dates for buddy lists and removing buddy lists when the expiration date has passed. This section of Malik is reproduced below (with emphasis added):

[0045] Referring now to FIG. 4, shown is a flowchart illustrating one embodiment, among others, of a flowchart illustrating the operation of the system of FIG. 3. The first step 400 in the operation is receiving a request to **add a temporary contact 300 to the resource list 305**. The universal server 130 can, in the next step 410, prompt the client 170 for an expiration date 335 for the temporary contact 300 to be stored in the resource list 305. In accordance with the next step 420, a default expiration period 335 for the temporary contact 300 can be set if the user does not specify an expiration 335. When a expiration date 335 is received, in the next step 430, the temporary contact 300 is recorded into the database system 250' along with a link to the unique identifier 325 and expiration date 335. The universal server 130 then checks if the temporary contact 300 is expired, in accordance with the next step 440. **If the temporary contact 300 is expired, the next step 450 is to remove the temporary contact 300 from the resource list 305.** However, if the temporary contact 300 is not expired, the universal server 130 can, according to the next step 460, wait and check for expiration again at the next login or a regular intervals. One skilled in the art will recognize that the universal server 130 can prompt the user about the permanence of a contact when a request to add a contact is received by the universal server 130. Moreover, the universal server 130 can prompt the user before removal of a temporary contact to confirm the removal or extension of an expired temporary contact.

As can be seen by the cited paragraph, in stark contrast to the assertions of the Office Action, unlike Applicant's claimed limitations, Malik teaches nothing regarding assigning expiration dates to “buddy groups” and removing buddy groups when their expiration dates have passed.

In short, neither Keskar nor Malik teach or suggest, either alone or in combination with one another, “creating a buddy list within a user's buddy list...”, “identifying an expiration date of the buddy group...”, “periodically comparing a current date to the expiration date corresponding to the buddy group”; and “removing the buddy

group... in response to the comparison.” As these limitations are included in each of Applicant’s claims 26, 28, and 30, Applicant respectfully submits that each of these claims is allowable over Keskar in view of Malik.

**Claims 1, 9, 17, 25, 27, and 29:**

The Office Action contends that the limitations added to claims 1, 9, 17, 25, 27, and 29 (originally found in claims 6, 14, and 22) are taught by the Knauerhase in combination with Keskar. Comparing the limitations added to claims 1, 9, 17, 25, 27, and 29 with the teachings of Knauerhase and Keskar, however, reveals that neither Knauerhase nor Keskar, taken alone or in combination with one another, teach or suggest Applicant’s claimed limitations.

Claims 1, 9, 17, 25, 27, and 29 have been amended to include limitations originally found in dependent claims 6, 14, and 22. These limitations include:

- creating a buddy group within the user’s buddy list, wherein the created buddy group corresponds to a selected calendar entry from an electronic calendar corresponding to the user;
- prior to the reception of the contact data:
  - selecting the calendar entry from the user’s electronic calendar; and
  - retrieving, from the selected calendar entry, calendar data that includes participant information for participants of the selected calendar entry; and
- subsequent to the reception of the contact data:
  - storing the received contact data in the buddy group, wherein the contact data received includes the participant information.

The Office Action admits that Knauerhase does not teach these additional limitations (Office Action, p. 18-19). However, the Office Action contends that these additional limitations are taught by Keskar. In the Applicant’s previous section of this Response (overcoming the rejections of claims 26, 28, and 30), Applicant clearly established that Keskar simply does not teach or suggest “creating a buddy group...” Instead, Keskar simply suggests that data can be added to a “buddy list” with no

teaching or suggesting of creating or including buddy groups within the buddy list, as taught and claimed by Applicant. Applicant further established that Keskar is void of any teaching or suggestion of "storing ... contact data in the buddy group..." Obviously, because Keskar fails to teach or suggest creating or using buddy groups, Keskar is equally unable to teach or suggest storing contact data in buddy groups. Each of Applicant's remaining independent claims (1, 9, 17, 25, 27, and 29), include these limitations and, therefore, each of these claims is allowable over Knauerhase in view of Keskar.

Applicant has overcome the rejections under 35 U.S.C. § 103 as applied to claims 1, 9, 17, 25, 27, and 29 and each of these claims is allowable over Knauerhase in view of Keskar. Claims 2-5 and 7-8 each depend, directly or indirectly, on claim 1 and, therefore, are allowable for at least the same reasons that claim 1 is allowable. Likewise, claims 10-13 and 15-16 each depend, directly or indirectly, on claim 9 and, therefore, are allowable for at least the same reasons that claim 9 is allowable. Finally, claims 18-21, and 23-24 each depend, directly or indirectly, on claim 17 and, therefore, are allowable for at least the same reasons that claim 17 is allowable.

### **Conclusion**

As a result of the foregoing, it is asserted by Applicant that the remaining claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Applicant respectfully request that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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